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09/897,480	07/03/2001	Michio Matsuura	1083.1082	2498

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EXAMINER
SHIFERAW, ELENI A

ART UNIT	PAPER NUMBER
2136	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *13 December 2006*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,2,4-8,10,15-19 and 21* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,2,4-8,10,15-19 and 21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *03 July 2001* is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a) ☐ All b) ☐ Some * c) ☐ None of:

  1. ☐ Certified copies of the priority documents have been received.

  2. ☐ Certified copies of the priority documents have been received in Application No. _____.

  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application

is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 CFR 1.114. Applicant's submission filed on 12/13/2006 has been entered.

Claim status

2.   Claims 3, 9, 11-14, and 20 are canceled.

3.   Claims 1-2, 4-8, 10, 15-19, and 21 are currently pending.

Response to Amendment

4.   Applicant's amendments and arguments are moot in view of new ground of

rejection(s).

Claim Objections

5.   Claim 15 is objected to because the word "top" in line 26 needs to be changed to

"to".

6.   Claim 1 recites the limitation "the read identifier" in line 10. There is insufficient

antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 3

wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read

identifier.

7.   Claim 2 recites the limitation "the read identifier" in line 17. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 11 wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read identifier.

8.   Claim 7 recites the limitation "the read identifier" in line 10. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 4 wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read identifier.

9.   Claim 7 recites the limitation "the transmitted identifier" in line 10. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 4 wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read identifier, and wherein "… the transmitted identifier, which is the same as the read identifier" changed to "the read identifier".

10.   Claim 8 recites the limitation "the read identifier" in line 9. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 4 wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read identifier.

11.   Claims 10 and 17 recite the limitation "the read identifier" in line 10. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 4 wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read identifier.

12.   Claims 10, 17, and 19 recite the limitation "the outside" in line 10. There is

insufficient antecedent basis for this limitation in the claim. Examiner suggests an amendment to

substitute "the outside" with "an outside" or "a central device" or "a recording device".

13.   Claim 15 recites the limitation "the read identifier" in line 16. There is insufficient

antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 9

wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read

identifier.

14.   Claim 16 recites the limitation "the read identifier" in line 11. There is insufficient

antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 4

wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read

identifier.

15.   Claim 16 recites the limitation "the transmitted identifier" in line 11. There is

insufficient antecedent basis for this limitation in the claim. Examiner suggests an amendment in

line 4 wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a

read identifier, and wherein "... the transmitted identifier, which is the same as the read

identifier" changed to "the read identifier".

16.   Claim 18 recites the limitation "the read identifier" in line 10. There is insufficient

antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 5

wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read

identifier.

17.   Claim 19 recites the limitation "the read identifier" in line 10. There is insufficient

antecedent basis for this limitation in the claim. Examiner suggests an amendment in line 4

wherein "an identifier" changed to "a read identifier", if the unique medium identifier is a read

identifier.

Drawings

18.   New corrected drawings in compliance with 37 CFR 1.121(d) are required in this

application because figures 1 and 15 require **legend**. The applicant for the patent is required to

furnish a drawing for his or her invention where necessary for the **clear understanding** of the

subject matter sought to be patented. The requirement for corrected drawings will not be held in

abeyance.

Claim Rejections - 35 USC § 102

19.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States
> before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States
> before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a)
> shall have the effects for purposes of this subsection of an application filed in the United States only if the international application
> designated the United States and was published under Article 21(2) of such treaty in the English language.

20.   Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Yokono et al.

USPN 6,529,946 B2.

Regarding claim 21, Yokono et al. discloses a contents processing system for providing contents

to a user, comprising:

a recording device including a processor capable of storing contents requested by the user

in advance (col. 6 lines 43-61, and col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15; *user*

*purchases a disk and registers the disk, based on **serial number/medium ID** of the disk and user identification, to*

download contents to user's disk, with public downloading apparatus management company 2, and when user

provides the disk to public downloading apparatus to have contents downloaded to the disk, the downloading

apparatus 1 checks the disk serial number and user identification, then if check is okay the user is allowed to

download user requested content that is provided from downloading apparatus management company 2 and stored

in public downloading apparatus 1), extracting the stored contents (col. 5 lines 10-col. 6 lines 61;

contents like daily electronic newspaper, news magazines, books, music are extracted from the contents server 4 and

provided/stored into public downloading apparatus 1 to be extracted and recorded to users personal disk) and

encrypting the extracted contents, based on an identifier having been given uniquely to an

optional medium prepared by the user and transmitted to the recording device in advance by the

user (col. 23 lines 8-col. 24 lines 65, and col. 17 lines 45-49; *public downloading apparatus extracting*

user requested content and enciphering the extracted content based on medium ID, user ID and password); and

an execution device including a processor capable of decrypting the contents recorded on

the medium prepared by the user and reproducing, displaying or executing the contents recorded

on the medium prepared by the user, based on the read identifier having been given uniquely to

the medium prepared by the user (col. 23 lines 8-col. 24 lines 65, col. 29 lines 47-col. 54, and

col. 10 lines 22-25; *deciphering contents recorded on the user disk*).

Claim Rejections - 35 USC § 103

21.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

22.   Claims 1, 7-8, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollar USPN 7,124,114 B1 in view of Spruit et al. US PG Pubs 2001/0030932 A1.

Regarding claim 1, Hollar discloses a contents processing method for providing contents to a user, comprising:

transmitting from a user an identifier having been given uniquely to an optional medium prepared by the user (col. 8 lines 5-13; *user transmitting unique CD identifier*);

storing contents as requested by the user in conjunction with the transmitted identifier in advance (col. 10 lines 35-67, and fig. 9 elements 903-904);

reading from the optional medium prepared by the user, the identifier having been given uniquely to the optional medium prepared by the user (col. 10 lines 35-54, col. 8 lines 5-13 and col. 7 lines 28-42; recipient identifier is read that is CD identifier/user's computer serial number);

extracting the stored contents, which have been stored in conjunction with the transmitted identifier, which is the same as the read identifier (col. 10 lines 52-62);

encrypting the extracted contents (col. 6 lines 59-67, and fig. 11; watermarking based on recipients identifier/CD identifier, and encrypted content);

recording the encrypted contents on the medium prepared by the user (fig. 7 and fig. 11);

accepting a limiting condition for reproducing, displaying or executing the contents by

the user (col. 8 lines 15-28);

recording the accepted limiting condition on the medium prepared by the user (col. 8

lines 22-35 and fig. 7); and

reproducing, displaying or executing the contents recorded on the medium prepared by

the user while decrypting the contents based on the identifier under the recorded limiting

condition (col. 10 lines 35-67, col. 12 lines 63-67 and col. 13 lines 6-20).

Hollar embeds/watermarks based on CD identifier (see col. 6 lines 59-67) and also

encrypts requested content based on usage information (see fig. 11). Hollar does not explicitly

disclose encrypting based on the read identifier. However Sprunt discloses providing unique

serial number to an optical disk and DVD at manufacturing and encrypting content data based on

the unique serial number of the medium, by a content provider (see par. 0029 lines 27-29).

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to employ the teachings of Sprunt within the system of Hollar because

they are analogous in content distribution. One would have been motivated to incorporate the

teachings of Hollar because it would identifier the key of the content encryptor based on serial

number.

Regarding claims 7 and 16, they are rejected under the same rational as claim 1 above.

Limitations of claims 7 and 16 are all disclosed in claim 21 above. In addition Hollar discloses

the additional limitation of claims 7 and 16 wherein:

accepting fees for recording the contents on the medium (see claim 47 and col. 7 lines 43-

56).

Regarding claims 8 and 18, all limitations of claims 8 and 18 are disclosed in claim 1 above and

they have been rejected under the same rational as claim 1.

Regarding claims 10, 17, and 19, Holler discloses an execution device/medium for reproducing,

displaying or executing contents to be provided to a user recorded on a medium, comprising:

a processor capable of performing the following operation:

reading an identifier having been given uniquely to an optional medium prepared by the

user (col. 10 lines 35-54, col. 8 lines 5-13, and col. 7 lines 28-42; *CD/DVD identifier/recipient*

identifier/computer SN);

accepting first specifying information for specifying the contents requested by a user (col.

8 lines 5-13, and lines 55-67);

accepting second specifying information for specifying other computer in which the

contents are to be recorded (col. 8 lines 5-67, fig. 6 elements 607, 610/614, 601, and col. 10 lines

32-67);

transmitting the accepted first specifying information, second specifying information and

the read identifier to the outside (col. 8 lines 5-13);

decrypting encrypted contents recorded on the medium prepared by the user (col. 10 lines

35-67), and stored in other computer in conjunction with the transmitted identifier, which is the

same as the identifier of the medium (col. 10 lines 35-67, fig. 9 elements 903-904); and

reproducing, displaying or executing the decrypted contents under a limiting condition

for reducing, displaying or executing the contents recorded on the medium prepared by the user

(col. 10 lines 35-67, col. 12 lines 63-67, and col. 13 lines 6-20).

Hollar embeds/watermarks based on CD identifier (see col. 6 lines 59-67) and also

encrypts requested content based on usage information (see fig. 11). Hollar does not explicitly

disclose encrypting based on the read identifier and/or medium identifier. However Sprunt

discloses providing unique serial number to an optical disk and DVD at manufacturing and

encrypting content data based on the unique serial number of the medium, by a content provider

(see par. 0029 lines 27-29).

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to employ the teachings of Sprunt within the system of Hollar because

they are analogous in content distribution. One would have been motivated to incorporate the

teachings of Hollar because it would identifier the key of the content encryptor based on serial

number.

23.   Claims 2, 4-6, and 15, are rejected under 35 U.S.C. 103(a) as being unpatentable

over Yokono et al. USPN 6,529,946 B2 in view of Hollar USPN 7,124,114 B1.

Regarding claims 2 and 15, Yokono et al. discloses a contents processing system for providing

contents to a user, comprising:·

a central device connected to the recording device via a communication network (col. 7

lines 25-col. 8 lines 41 and fig. 1 elements 1, 2, 3, 4, 5, and 6);

the execution device includes a processor capable of performing the following operations:

reading an identifier having been given uniquely to an optional medium prepared by the

user (col. 15 lines 11-66 and col. 18 lines 45; *medium ID/serial number of the disk is read by the*

public downloading apparatus 1 and/or public downloading apparatus management company 2)

accepting first specifying information for specifying contents requested by the user (col.

14 lines 53-65 and col. 7 lines 55-col. 8 lines 3; *public downloading apparatus accepting first*

specifying info. Download ID/file name);

accepting second specifying information for specifying a recording device in which the

contents are to be recorded (col. 5 lines 10-col. 6 lines 61; *public downloading apparatus*

accepting second specifying info..... where content is updated from(public downloading

apparatus management company 2 address)...credit card company 3 address,..... where content

is providing from(content company 4 address)...from users stored information on a disc.); and

transmitting the accepted first specifying information, second specifying information and

the identifier having been given uniquely to the medium prepared by the user to the central

device (col. 5 lines 10-col. 7 lines 67; *public downloading apparatus 1 transmitting user stored*

info. from the disk to appropriate central server (Download ID to contents company 4,

authenticator device name and update device name to credit card company 3, contents company

4, public downloading apparatus management company 2...));

the central device includes a processor capable of performing the following operations:

extracting contents from a content database storing contents, based on the transmitted

first specifying information (col. 5 lines 10-col. 6 lines 61); and

transmitting the extracted contents and the transmitted identifier to a recording device

corresponding to the transmitted second specifying information (col. 5 lines 10-col. 7 lines 67);

the recording device includes a processor capable of performing the following operations:

storing the transmitted contents in advance in conjunction with the transmitted identifier

(col. 7 lines 37-col. 8 lines 3, and col. 6 lines 11-15; *user purchases a disk and registers the disk,*

*based on **serial number/medium ID** of the disk and user identification, to download contents to*

user's disk, with public downloading apparatus management company 2, and when user

provides the disk to public downloading apparatus to have contents downloaded to the disk, the

*downloading apparatus 1 checks the disk serial number and user identification **with stored**, then*

if check is okay the user is allowed to download user requested content that is provided from

*downloading apparatus management company 2 and **stored** in public downloading apparatus 1*

based on serial number);

reading an identifier having been given uniquely to optional (fig. 13 *unique MEDIUM ID*)

medium prepared by the user (col. 15 lines 11-66 and col. 18 lines 45; *medium ID/serial number*

of the disk is read by the public downloading apparatus 1 and/or public downloading apparatus

management company 2);

extracting the stored contents, which has been stored in conjunction with the transmitted

identifier, which is the same as the read identifier (col. 5 lines 10-col. 6 lines 61, and col. 14 lines

53-65; *contents like daily electronic newspaper, news magazines, books, music are extracted*

from the contents server 4 and contents are stored based on request Download ID);

encrypting the extracted contents, based on the read identifier (col. 23 lines 8-col. 24 lines

65, and col. 17 lines 45-49; *public downloading apparatus extracting user requested content and*

enciphering the extracted content based on medium ID, user ID and password);

recording the encrypted contents on the medium prepared by the user (col. 17 lines 45-49;

recording encrypted user contents on users disk);

accepting a limiting condition for reproducing, displaying or executing the contents by the

user (col. 15 lines 64-col. 16 lines 66; ***use record information*** *public downloading apparatus 1*

accepting starting and finishing time...date...month...year...hrs...min...seconds...); and

recording the accepted limiting condition on the medium prepared by the user (fig. 8 and

col. 15 lines 64-col. 16 lines 66; *recording use record info on the user's disk),*

the processor of the execution device is further capable of performing the following

operation:

reading the identifier of the medium prepared by the user (col. 15 lines 11-66, col. 18

lines 45, and fig. 13; *reading medium ID/serial number of the user's disk);*

decrypting the contents recorded on the medium prepared by the user in an encrypted

form, based on the read identifier (col. 23 lines 8-col. 24 lines 65, ; *deciphering contents*

recorded on the user disk); and

reproducing, displaying or executing the decrypted contents under the limiting condition

recorded on the medium prepared by the user (col. 29 lines 47-col. 54, and col. 10 lines 22-25).

Yokono et al. discloses a method of public downloading apparatus and the user

approaches a public downloading apparatus with a user possession disk to download data from

central content company 4. The user uses the public device the public downloading device to

request and view content and does not explicitly disclose an execution device connected to a

central device and recording device via a communication network. However, Hollar discloses the

well-known remote user device (laptop or computer) connected to a central content device and

recording device and the user transmitting required content name (col. 8 lines 5-13), user's

CD(DVD) identifier/device number/identity (col. 8 lines 5-13; *user transmitting unique CD*

identifier), and recording apparatus name information to the central device (col. 6 lines 23-65)

and the central device transmitting the request information with the requested content to

identified recording apparatus and the recording apparatus first storing information in the system

and recording to users device (col. 8 lines 5-67, fig. 6 elements 607, 610/614, 601, and col. 10

lines 32-67).

Therefore it would have been obvious to one having ordinary skill in the art at the time of

the invention was made to employ the teachings of Hollar within the system of Yokono et al.

because they are analogous in content recording. One would have been motivated to incorporate

the teachings of Hollar because it is well known to request content remotely and provide content

remotely.

Regarding claim 4, Yokono et al. further teaches the contents processing system/apparatus,

wherein the contents are web pages, and the first specifying information is a search

searching for web pages, and the processor of the central device extracts a web page

corresponding to the transmitted search keyword and web pages linked to the web page from the

content database, based on the search keyword, for extraction of the contents (col. 6 lines 4-15;

content server....electronic contents... and it is very well known at the time of the invention to

search for web pages and extract a web page based on the user transmitted keyword please see

Peinado et al. (Peinado, Patent No. US 6,772,340 B 1). One would have been motivated to

modify the combination electronic information to web page because it would include web

content to be provided to users.

Regarding claim 5, Yokono et al. further teaches the contents processing system/apparatus,

wherein the processor of the central device is further capable of performing an operation of

accepting a limit number of times for limiting the number of times of linking between the web

page corresponding to the search keyword and web pages linked to the web page, and the

processor of the central device extracts the web page corresponding to the transmitted search

keyword and web pages linked to the web page within the accepted limit number of times from

the content database, based on the search keyword, for extraction of the contents (col. 6 lines 4-

15; content server....electronic contents... and it is very well known at the time of the invention

to search for web pages and extract a web page based on the user transmitted keyword please see

Peinado et al. (Peinado, Patent No. US 6,772,340 B 1).

Regarding claim 6, Yokono et al. further teaches the contents processing system, wherein the

processor of the execution device is further capable of performing an operation of transmitting a

URL of a web page which is not stored on the medium prepared by the user to the central device

when the web page is to be displayed on a browser (col. 6 lines 4-15; content server....electronic

contents... and it is very well known at the time of the invention to search for web pages URL

and extract a web page based on the user transmitted keyword please see Peinado et al. (Peinado,

Patent No. US 6,772,340 B 1).

Conclusion

24.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867.

The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nasser R. Moazzami can be reached on (571) 272-4195. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

February 12, 2007

2/15/07